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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,025	11/21/2001	Travis J. Parry	10008081-1	2759
7590 07/25/2008 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			EXAMINER WIDHALM, ANGELA M	
			ART UNIT 2152	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/990,025

Applicant(s)

PARRY, TRAVIS J.

Examiner

ANGELA WIDHALM

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 May 2008 has been entered.

2. This is a non-final office action in response to remarks filed on 9 May 2008. Claims 1-10, 12-13, and 14-20 were amended. No claims were canceled or added. Claims 1-20 are pending.

Response to Arguments

3. Applicant's arguments filed 9 May 2008 have been fully considered but they are not persuasive.

4. In response to applicant's statement that McIntyre discloses two separate embodiments and are therefore not combinable, MPEP 2136.02 explains that a 35 U.S.C. 102(e) rejection may rely on any part of the patent or application publication disclosure. Under 35 U.S.C. 102(e), the entire disclosure of a U.S. patent, a U.S. patent application publication, or an international application publication having an earlier effective U.S. filing date (which will include certain international filing dates) can be

relied on to reject the claims. *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 983, 10 USPQ2d 1338, 1342 (Fed. Cir. 1989). See MPEP § 706.02(a).

All embodiments disclosed by McIntyre describe a control program commanding a printer to use another printer's control settings (see [0029], [0034]-[0035]). The location of the control program may differ in these embodiments, however otherwise the embodiments teach the same functions and are not mutually exclusive.

The claims describe three printers, one of which is to be updated, the second has the template configuration, and the last has management capabilities for commanding the first printer. The second and third printers are logically distinct, but not physically distinct, from one another. McIntyre's printer 221 has both these capabilities and is therefore functionally equivalent to the claimed second and third printers.

Within the second embodiment of McIntyre, a printer 221, i.e. second and third printers, stores its control settings in storage media 240 (see [0033]). Storage media 240 is also accessible to printers 220 (see [0033]). Printers 220 retrieve control settings for printer 221 from storage media 240 after receiving an update command (see [0034]-[0035]). This update command comes from the printer control program 250 from within printer 221 (see [0035]).

5. In response to applicant's arguments that McIntyre does not disclose the new amendments, applicant is directed to the explanations provided in the rejections below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-14 and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Independent claims 1, 6, and 8 and dependent claims 16-18 were amended to describe the management facility is an additional printer, however applicant's specification does not support this. Claims 2-5, 7, and 9-14 depend from claims 1, 6, and 8 and are also rejected for these reasons.

b. Dependent claims 3 and 9 describe "a predetermined structure of printer configurations" however it is unclear what is meant by this amendment. No explanation was found in applicant's specification.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3, 5-7, 9, 13, and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

c. Dependent claims 3 and 9 describe a storage location associated with the second printer having one of a variety of data explained in greater detail in the claims. Storage location may be a file itself or a physical storage device or the network address of a storage device.

d. Dependent claims 5, 13, and 19 describe the second printer is dissimilar to the first printer; however the term 'dissimilar' is indefinite because there is no defined scope for the term. For example, two printers are dissimilar if they have the same configuration or the same model but are located at different network locations. Two printers are also dissimilar if they use different languages or protocols and also if two printers differ only in color.

e. Independent claim 6 states "communicating from a first printer having a device configuration with an internal management facility;" however this limitation has multiple interpretations. The first interpretation is that a first printer sends communication to an internal management facility, however if this is the case, then it is unclear where the internal management facility is located. Another interpretation is that the internal management facility is located within the first

printer and initiates outgoing communication. Claim 7 is also rejected for these reasons because of its dependency from claim 6.

f. Claim 17 recites the limitation "the imaging device" in line 5. There is insufficient antecedent basis for this limitation in the claim.

g. Regarding claim 18, it is unclear whether "retrieving the device configuration of a selected third printer with the management facility" means that 1) the management facility retrieves the device configuration of a selected third printer or 2) the management facility resides within the third printer. For purposes of examination, examiner uses the second interpretation.

Summary of Claimed Invention

10. The claimed invention relates to an imaging device, computer-usable medium, and methods for upgrading the configuration of a device based on another device's configuration. The system uses the configuration settings of a model device to automatically configure other devices. In which, in the same field of invention, the applied reference teaches the same.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by McIntyre (U.S. Patent Publication 2003/0063305).

13. Regarding claim 1, McIntyre disclosed a printer comprising:
- a network interface adapted for coupling to a network (*see [0034], [0022]*); and
- a processing facility, wherein the processing facility is adapted to request a device configuration to upgrade an internal configuration of the printer from a second printer through the network interface (*Printers 220 retrieve configuration settings for printer 221 from storage media 240, see [0034]*) in response to receiving an external upgrade command through the network interface from an external management facility (*Printer 221 sends an update command to printers 220, see [0035]*) and a network location of the second printer (*It is inherent that the location of the stored configuration settings be sent in order for the printers 220 to be able to retrieve the configuration settings*), and where the external management facility is resident on a third printer (*Printer control program 250 is resident on printer 221 and printers 220, see [0032]*).

The claimed second and third printers each have a separate functionality, i.e. second printer has the template configuration and third printer has management capabilities for commanding another printer. The second and third printers are logically

distinct, but not physically distinct, from one another. McIntyre's printer 221 has both capabilities and is therefore functionally equivalent to the claimed second and third printers. Within embodiment 2 of McIntyre, a printer 221, i.e. second and third printers, stores its control settings in storage media 240 (see [0033]). Storage media 240 is also accessible to printers 220 (see [0033]). Printers 220 retrieve control settings for printer 221 from storage media 240 after receiving an update command (see [0034]-[0035]). This update command comes from the printer control program 250 from within printer 221 (see [0035]).

14. Regarding claim 6, McIntyre disclosed a computer-usable medium having computer-readable instructions stored thereon for execution by a processor to perform a method comprising:

communicating from a first printer having a printer configuration with an internal management facility (*Printer 221 sends an update command to printers 220, see [0035] using the printer control program 250 that is resident on printer 221, see [0032];*

communicating with a defined list of second printers, each second printer having a configuration (*Printer control program 250 resident on printer 221 contains a list of printers 220 and sends update commands to the printers 220 on this list, see [0035];*
and

directing the second printers with the internal management facility of the first printer to update their device configuration using a device configuration of a third printer (*Printer 221 sends update commands to the printers 220 to use the configuration*

settings of printer 221, see [0035]. The claimed first and third printers each have a separate functionality, i.e. third printer has the template configuration and first printer has management capabilities for commanding another printer. The first and third printers are logically distinct, but not physically distinct, from one another. McIntyre's printer 221 has both capabilities and is therefore functionally equivalent to the claimed first and third printers) in a manner selected from the group consisting of: retrieving the printer configuration from the third printer, storing the printer configuration of the third printer in a storage location (Printer 221 stores its configuration settings in storage media 240, see [0033]), and directing each of the second printers to retrieve the printer configuration of the third printer from the storage location; and directing each of the second printers to retrieve the printer configuration from the third printer (Printers 220 retrieve configuration settings for printer 221 from storage media 240, see [0034]).

15. Regarding claim 8, McIntyre disclosed a method of updating device configuration for printers connected to a network, comprising:

defining a list of similar first printers connected to the network, wherein the similar first printers share a common configuration, firmware, software, or supplemental information (*Printer control program 250 resident on printer 221 contains a list of printers 220, i.e. list of similar first printers, to be updated with the configuration settings of printer 221, see [0035];*

defining a network location associated with a second printer having a desired device configuration for the list of similar first printers (*Printer 221, i.e. second printer,*

stores its configuration settings in storage media 240, see [0033]. Storage media 240 is also accessible to printers 220, see [0033]. Printers 220 retrieve configuration settings for printer 221 from storage media 240, see [0034]-[0035]; and

directing each printer of the list of similar first printers with a management facility to retrieve the device configuration from the network location of the second printer, by communicating with each printer of the list of similar first printers across the network with the management facility (Printer control program 250 resident on printer 221, i.e. third printer, contains a list of printers 220 and sends update commands to the printers 220 on this list to use the configuration settings of printer 221, see [0035]. The configuration settings for printer 221 are stored in storage media 240, see [0033]. Printers 220 retrieve control settings for printer 221 from storage media 240, see [0034]-[0035]), wherein the management facility is an embedded webserver of a third printer (Printer control program 250 resides on printer 221, i.e. third printer (see [0035]). Printers communicate via a network (see [0034]), e.g. Internet, (see [0022]). The claimed second and third printers each have a separate functionality, i.e. second printer has the template configuration and third printer has management capabilities for commanding another printer. The second and third printers are logically distinct, but not physically distinct, from one another. McIntyre's printer 221 has both capabilities and is therefore functionally equivalent to the claimed second and third printers).

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16. Regarding claim 15, McIntyre disclosed a method of upgrading a first printer, comprising:

receiving across a network an external upgrade command from an external management facility and a network location of a second printer associated with a desired device configuration for the first printer (*Printers 220, i.e. first printer, retrieve control settings for printer 221, i.e. second printer, from storage media 240 after receiving an update command (see [0034]-[0035]). It is inherent that the location of the stored configuration settings be sent in order for the printers 220 to be able to retrieve the configuration settings*); and

retrieving the desired device configuration from the network location of the second printer with the first printer and upgrading the configuration of the first printer (*Printers 220 retrieve configuration settings for printer 221 from storage media 240, see [0034]-[0035]).*

17. Regarding claim 2, McIntyre disclosed the device configuration from the second printer is requested from a storage location associated with the second printer (*Printers 220 retrieve configuration settings for printer 221 from storage media 240, see [0034]-[0035]).*

18. Regarding claims 3 and 9, McIntyre disclosed wherein the network location associated with the second printer has one of a predetermined structure of printer configurations, predetermined directory structure, an index file, and a database of

upgrades for printer version, type, manufacturer and printer features for each printer of the list of first printers (*Storage media 240 stores printer configuration settings, see [0033]-[0034]*).

19. Regarding claims 4, 7, and 11, McIntyre disclosed the device configuration from the second printer is selected from a group consisting of at least one of: firmware code, software code, supplemental data, and a configuration parameter (see *[0035], [0024]*).

20. Regarding claims 5, 13, and 19, McIntyre disclosed wherein the second printer is dissimilar to printers of the list of similar first printers (*Printer 221, i.e. second printer, sends update commands to printers 220, i.e. first printers. Printers 220 are separate from the printer 221 and are therefore considered dissimilar to the printer 221*), and where the device configuration from the second printer is converted to upgrade the first printer (claims 5, 19) or be compatible with each printer of the list of similar first printers (claim 13) by one of a mask, a configuration mapping function of the management facility, a matching of the configuration of the second printer to an upgrade package on the storage location, and by a matching of a functionality from the second printer to include on the printer during upgrade (*Configuration settings for printer 221, i.e. second printer, are stored in formats readable by printers 220, i.e. first printers, see [0033]. The control program compares configuration settings and highlights the differences, see [0031]. This is functionally equivalent to a configuration mapping function of the management facility*).

21. Regarding claim 10, McIntyre disclosed initiating a follow-up update on each printer of the list of similar first printers if the device configuration of the second printer is changed (*see [0030]-[0031]*).

22. Regarding claim 12, McIntyre disclosed wherein the device configuration from the second printer comprises at least one configuration parameter, where a mask is applied to the at least one configuration parameter to exclude portions thereof from being changed on each printer of the list of similar first printers while being upgraded (*see [0028]*).

23. Regarding claim 14, McIntyre disclosed periodically checking for changes in device configuration, and if a change is noted, initiating a follow-up update (*see [0031]*).

24. Regarding claim 16, McIntyre disclosed the desired device configuration is that of a third printer, wherein the third printer shares a common configuration, firmware, software, or supplemental information with the first printer (*see [0035]*).

25. Regarding claim 17, McIntyre disclosed receiving the external command from the external management facility, wherein the management facility resides on a platform that is selected from the group consisting of: a workstation, a server, a network device, a management interface on the imaging device, an embedded webserver in a printer, and a master printer (*see [0032], [0035]*).

26. Regarding claim 18, McIntyre disclosed the invention, substantially as claimed, as described above in claim 15, further comprising:

retrieving the device configuration of a selected third printer with the management facility (*Printer control program 250 resident on printer 221, i.e. third printer, sends update commands to the printers 220 to use the configuration settings of printer 221, see [0035]*); and placing the device configuration at the network location of the second printer (*The configuration settings for printer 221 are stored in storage media 240, see [0033]-[0034]*).

As explained above in paragraph g, the third printer is interpreted as the printer with the management facility that sends the update command. This is logically separate from the second printer that has the template configuration. It was already established in the rejection of parent claim 15 that printer 221 is equivalent to the claimed second printer. Printer 221 is functionally equivalent to both the claimed second and third printers because printer 221 has both the capability to have the template configuration, i.e. the claimed second printer, and management functionality for commanding another printer, i.e. the claimed third printer.

27. Regarding claim 20, McIntyre disclosed the first printer selects an appropriate version of the desired device configuration from the network location of the second printer to match its type (*Ensuring that the appropriate version is downloaded is inherently included when downloading firmware updates, see [0030], [0037]*).

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Schlonski et al. U.S. Patent Publication 2002/0196451.

29. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Widhalm whose telephone number is (571)272-1035. The examiner can normally be reached M-F, 9-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob

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Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. W./
Examiner, Art Unit 2152
17 July 2008

/Bunjod Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2152